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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/148,474 09/08/98 TAKASU

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TM02/1107
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NEW YORK NY 10112-3801

EXAMINER

PAULA, C

| | |
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| ART UNIT | PAPER NUMBER |
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2176

DATE MAILED:

11/07/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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|------------------------------|---------------------------|------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/148,474 | TAKASU ET AL. |
| | Examiner CESAR B PAULA | Art Unit 2176 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) Responsive to communication(s) filed on 12/20/99.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-31 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) All b) Some * c) None of the CERTIFIED copies of the priority documents have been:
1. received.
 2. received in Application No. (Series Code / Serial Number) _____.
 3. received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____
- 16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)
- 17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 20) Other: _____

DETAILED ACTION

1. This action is responsive to the application filed on 9/8/1998.

This action is made non-final.

2. Claims 1-31 are pending in the case. Claims 1, 10, 14, 26, and 30-31 are independent claims.

Priority

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d), and based on application # 9-243,991 filed in Japan on 9/9/1997, which papers have been placed of record in the file.

Information Disclosure Statement

4. The information disclosure statement filed 12/20/1999 has been considered.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: SHIFTING AND REPLYING/FORWARDING RECEIVED EMAIL DOCUMENTS.

a. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

(a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because it is not describing the invention as claimed, and is misleading in that pages 5-43 describe a system for inputting, and coordinating text, image, digitized pen strokes, and voice data into a document, and compression of data. Appropriate correction is requested.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

8. Claims 1-2, and 4-31 rejected under 35 U.S.C. 102(a) as being anticipated by over Mosher, MS Exchange Users Handbook (3/1/1997).

Regarding independent claim 1, Mosher discloses: *storing a received mail document -- “You can save messages*” (p.1). Mosher teaches the saving of email messages onto a computer.

Moreover, Mosher discloses: *deriving a shift amount of an output position of said received mail document...., and outputting said received mail document.....*--“Figure 12.9 When you reply to a message....indenting the message text and including header

” (p.4, and 7). Mosher teaches display of the shifting of email messages by inserting new text string and header in a computer screen with an appropriate “derived’ amount of vertical space.

Regarding claim 2, which depends on claim 1, Mosher discloses:*said received mail document comprises locus information to define the output position by coordinate values--*“Figure 12.9 When you reply to a message....indenting the message text and including header

” (p.4). Mosher teaches the shifting of email text at the starting position—*locus information--* by inserting text strings, and header at the starting location, and shifting the received message both vertically and horizontally.

Regarding claim 4, which depends on claim 1, Mosher discloses:*said character string to be inserted is an inserting comment text--*“...how much text of the incoming message to quote” (p.3). Mosher teaches the shifting of email text at the starting position by inserting text strings, and header—*comment text--* at the starting location.

Regarding claim 5, which depends on claim 1, Mosher discloses:*said character string can be edited--*“...how much text of the incoming message to quote” (p.3). Mosher teaches the shifting of email text at the starting position by inserting text strings, and header—*comment text--* at the starting location.

Regarding claim 6, which depends on claim 1, Mosher discloses:*the shift amount is length information--*“...how much text of the incoming message to quote” (p.3). Mosher teaches the shifting of email text at the starting position by the length of text strings, and header—*comment text--* at the starting location.

Claims 7-9 are directed towards a method for implementing the steps found in claim 6, and are similarly rejected.

Claim 10 is directed towards a method for implementing the steps found in claims 1-2, and is similarly rejected.

Regarding claim 11, which depends on claim 10, Mosher discloses:*deviation amount derived is a difference between a position of said text information.....--*“...how much text of the incoming message to quote” (p.3). Mosher teaches the shifting of email text at the starting position by the difference of the quoted text and inserted text strings, and header from the starting location.

Claims 12-15, 17-22 are directed towards an information processing apparatus for implementing the steps found in claims (1-2), 2, and 1-2, and 4-9 respectively, and are similarly rejected.

Regarding claim 23, which depends on claim 14, Mosher discloses:*output means is an inkjet printer--* (p.9). Mosher teaches use of a print file icon to print the email in a printer such as an inkjet printer.

Claims 24-29 are directed towards an information processing apparatus for implementing the steps found in claims 23, 1, 10-13 respectively, and are similarly rejected.

Claims 30-31 are directed towards a storage medium for storing instructions for implementing the steps found in claims 1, and 10 respectively, and are similarly rejected.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher.

Regarding claim 3, which depends on claim 1, Mosher discloses: "...how much text of the incoming message to quote" (p.3). Mosher fails to explicitly disclose:*said character string to be inserted is a quotation symbol.* However, it would have been obvious to a person of

ordinary skill in the art at the time of the invention to have included the quotation symbol, because Mosher teaches above, quoting text in a reply email message.

Claim 16 is directed towards an information processing apparatus for implementing the steps found in claim 3, and is similarly rejected.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. LUCAS et al. (Pat. # 5,528,739), NIELSEN (Pat. #6,108,688, AND 5,870,548), and HAN (Pat. # 5,872,925).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

Art Unit: 2176

- (703) 308-9051, (for formal communications intended for entry)

Or:

- (703) 308-5403, (for informal or draft communications for discussion only, please label “**PROPOSED**” or “**DRAFT**”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

cbp

10/25/00

Heather R Herndon
HEATHER R. HERNDON
SUPERVISORY PATENT EXAMINER
GROUP 2700